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| APPLICATION NO.   | FILING DATE    | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |  |  |
|---|----------------|----------------------|-------------------------|------------------|--|--|
| 10/019,696 06/20/2002   |                | David Finn           | 70357                   | 70357 3879       |  |  |
| 23872 75  | 590 12/04/2003 |                      | EXAM                    | EXAMINER         |  |  |
| MCGLEW & TUTTLE, PC<br>SCARBOROUGH STATION<br>SCARBOROUGH, NY 10510 |                |                      | VU, QU                  | VU, QUANG D      |  |  |
|   |                |                      | ART UNIT                | PAPER NUMBER     |  |  |
| Germbonee   | 011, 117 10310 |                      | 2811                    |                  |  |  |
|   |                |                      | DATE MAR ED. 12/04/2002 |                  |  |  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|  |  |  |  | <u> </u>   |            |  |  |  |
|--|--|--|--|--|------------|--|--|--|
| -  |  | Applica  | tion No.   | Applicant(s)   |            |  |  |  |
|  |  | 10/019,  | 696  | FINN ET AL.  |            |  |  |  |
|  | Office Action Summary  | Examin   | er   | Art Unit   |            |  |  |  |
|  | · .  | · Quang [  |  | 2811   |            |  |  |  |
| The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply   |  |  |  |  |            |  |  |  |
|  | A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  |  |  |  |            |  |  |  |
| THE I - Exter after - If the - If NO - Failu - Any r   | MAILING DATE OF THIS COMMUNICATION OF THIS C | ATION.  37 CFR 1.136(a). In no a cication.  days, a reply within the st tory period will apply and li. by statute, cause the a | event, however, may a rep<br>latutory minimum of thirty (<br>will expire SIX (6) MONTH<br>pplication to become ABA | ly be timely filed<br>30) days will be considered timely.<br>4S from the mailing date of this commu<br>NDONED (35 U.S.C. § 133). | inication. |  |  |  |
|  | Responsive to communication(s) filed   | on 21 October 20   | 003  |  |            |  |  |  |
| , <del></del>  | This action is <b>FINAL</b> . 2b)⊠ This action is non-final.   |  |  |  |            |  |  |  |
| /  | Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.  |  |  |  |            |  |  |  |
| Disposition of Claims  |  |  |  |  |            |  |  |  |
| 4)🖂  | Claim(s) 1-7 is/are pending in the app   | lication.  |  |  |            |  |  |  |
| -  | 4a) Of the above claim(s) is/are withdrawn from consideration.   |  |  |  |            |  |  |  |
| 5)   | 5) Claim(s) is/are allowed.  |  |  |  |            |  |  |  |
| 6)⊠  | 6) Claim(s) 1-7 is/are rejected.   |  |  |  |            |  |  |  |
| •  | Claim(s) is/are objected to.   |  |  |  |            |  |  |  |
| 8)[  | Claim(s) are subject to restriction  | on and/or election   | requirement.   |  |            |  |  |  |
| Applicati  | on Papers  |  |  |  |            |  |  |  |
| ,—   | The specification is objected to by the  |  | _  |  |            |  |  |  |
| 10)  | The drawing(s) filed on is/are: a  |  |  |  |            |  |  |  |
|  | Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  |  |  |  |            |  |  |  |
| 11\  | Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.   |  |  |  |            |  |  |  |
|  |  |  |  |  |            |  |  |  |
| Priority under 35 U.S.C. §§ 119 and 120  |  |  |  |  |            |  |  |  |
| <ul> <li>12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</li> <li>a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No.</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> <li>13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.</li> <li>37 CFR 1.78.</li> <li>a) The translation of the foreign language provisional application has been received.</li> <li>14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.</li> </ul> |  |  |  |  |            |  |  |  |
| Attachmen  |  |  |  | (DTO 440) De   |            |  |  |  |
| 2) Notic   | ee of References Cited (PTO-892) se of Draftsperson's Patent Drawing Review (PTO mation Disclosure Statement(s) (PTO-1449) Pap   |  |  | mmary (PTO-413) Paper No(s)<br>ormal Patent Application (PTO-152   |            |  |  |  |

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### **DETAILED ACTION**

### Election/Restrictions

Applicant's election with traverse of group I, claims 1-7 in Paper No. 10 is acknowledged. The traversal is on the ground (s) that the restriction is not proper. This is not found persuasive because group II (claims 8-14) and group I (claims 1-7) are related as process of making and product made, respectively. Additionally, the device of group I (claims 1-7) invention could be made by a materially different process. For example, forming the chip and the contact metallizations of the chip on the temporary substrate and contacting the conductive connection strands with the carrier film to the contact metallizations of the chip, and then remove the temporary substrate, instead of applying conductive connection strands on the carrier film and contacting contact metallizations of the chip with the conductive connection strands.

The requirement is still deemed proper and is therefore made FINAL.

## Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 2. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,176,853 to Sarma et al.

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Regarding claim 1, Sarma et al. (figure 9) teach a chip carrier for forming a chip module, the chip carrier comprising:

a substrate formed by a carrier film (409); and

connection leads (509) arranged on the substrate, the connection leads (509) comprising strips and extend parallel over the substrate, the connection leads (509) comprising electrically conductive connection strands arranged on the substrate in a single plane and extending in a planar direction over the substrate surface and having a longitudinal expansion flush with the substrate surface.

Regarding claim 2, Sarma et al. inherently teach the carrier film (409) is provided with at least one additional conductive strand (98) on a side opposite the connection strands (509) to generate a capacitance, wherein the insulating carrier film (409) is arranged as an intermediated layer between the connection strands (509) on the one hand and the conductive strand (98) on the other.

Regarding claim 3, Sarma et al. teach the connection strands (509) are at least sectional provided with a connecting material coating for contacting with the contact metallizations (309) of a chip (209).

Regarding claim 4, Sarma et al. teach the connection strands (509) are at least sectional provided with a contact metallizations (309) for contacting with the contact metallizations of a chip (209).

Regarding claim 6, Sarma et al. (figure 9) teach a chip module, comprising:

a chip carrier comprising a substrate formed by a carrier film (409) and connection leads (509) arranged on the substrate, the connection leads (509) comprising stripes and extend parallel

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over the substrate, the connection leads (509) comprising electrically conductive connection strands arranged on the substrate in a single plane and extending in a planar direction over the substrate surface and having a longitudinal expansion flush with the substrate surface; and

connecting surfaces with elevated contact metallizations (309), the contact metallizations (309) being in contact with a top side of the connection strands (509) facing away from the carrier film (409).

## Claim Rejections - 35 USC § 103

- 3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,176,853 to Sarma et al. in view of US Patent No. 6,326,233 to Hashimoto.

Regarding claim 5, Sarma et al. differ form the claimed invention by not showing the connection strands are connected with the terminals of a coil unit. However, Hashimoto (figures 7-8) teaches the connection strands (20) are connected with the terminals of a coil unit. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teaching of Hashimoto into the device taught by Sarma et al. because it increase the productivity of the device. The combined device shows the connection strands are connected with the terminals of a coil unit.

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Regarding claim 7, Sarma et al. teach the connection strands (509) are in contact with the contact metallizations (309) of the chip (209). Sarma et al. differ from the claimed invention by not showing the connection strands are connected with the terminals of a coil unit. However, Hashimoto (figures 7-8) teaches the connection strands (20) are connected with the terminals of a coil unit. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teaching of Hashimoto into the device taught by Sarma et al. because it increase the productivity of the device. The combined device shows the connection strands are connected with the terminals of a coil unit.

## **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang D Vu whose telephone number is 703-305-3826. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie Lee can be reached on 703-308-1690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

qv

November 28, 2003

EDDIE LEE

SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800